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EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2142

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,311

Applicant(s)

LALA ET AL.

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-4,6-21 and new claims 22-23 are pending. Claim 5 is canceled.

Response to Arguments

2. Applicant's arguments filed 11/14/05 have been fully considered but they are not persuasive to overcome the prior art.

(A). As per claims 1,2,7,11,12 and 17, Applicant argues the prior art has failed to set forth a *prima facie* because no proper combination .

Examiner points out the claim subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See *In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejection based on Eggleston teaches a method for enabling a web server to provide a commercial promotion [Eggleston, Weber server, an incentive program with award, col 6 lines 25-45, Fig1], comprising the act of:

detecting a qualifying value (i.e.: a prize, award, reward) of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 41 lines 5-25];

when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code, and executing the module of selectively executable compiled web server code that provides the promotion [Eggleston, a database with incentive program, col 12 lines 12-col 41 lines 5-38].

wherein the associating is made explicitly by pointers that are included in terms of the promotions [Eggleston, a pointer, col 34 lines 1-20].

Eggleston does not explicitly detail “checking (or searching) a database of promotions for presence of a promotion that includes the qualifying value (or qualifying parameters)”.

Lakritz teaches the database search engine can search by a specified qualifying parameters or qualifying value.

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the search limited by specified qualifying parameters as taught by Lakritz into the Eggleston's apparatus in order to utilize the database search. Doing so would provide the consumer a simple, fast, easy to use system for generating, identifying and recognizing the interested subjects [Lakritz, col 3 lines 65-col 4 line 3]. Thus the combination is proper.

(B). As per claim 2, Applicant argues the prior art does not teach ““checking a database of promotions for presence of a promotion that includes the qualifying value; when a promotion that includes the qualifying value is present in the database; determining a reward value of the promotion that includes the qualifying value based on associating a module of selectively executable compiled web server code residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion; and executing the module of selectively executable compiled web server code associated with the reward.”

Examiner points out that the prior art taught "checking a database of promotions for presence of a promotion that includes the qualifying value [Eggleston, a database with incentive program, col 12 lines 12-col 41 lines 5-38]; a promotion that includes the qualifying value is present in the database [Lakritz a search engine can search by a specified qualifying parameters or qualifying value, abstract]; determining a reward value of the promotion that includes the qualifying value based on associating a module of selectively executable compiled web server code (residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion); executing the module of selectively executable compiled web server code associated with the reward [Eggleston, associate prizes with incentive program, abstract].

The prior art does not explicitly detail "residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion". It was obvious the incentive program stored and executed by server [Eggleston, col 6 lines 30-46]. The program resides on server body or remote machine is an alternative arrangement and Rearrangement of Parts is not Patentability. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the

reference device.” Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable by Eggleston et al [Eggleston 6,061,660] in view of Lakritz [5,586,198].

3. As per claim 1, Eggleston discloses a method for enabling a web server to provide a commercial promotion [Eggleston, Weber server, an incentive program with award, col 6 lines 25-45, Fig1], comprising the act of:

detecting a qualifying value (i.e.: a prize, award, reward) of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 41 lines 5-25];

when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code, and executing the module of selectively executable compiled web server code that provides the promotion [Eggleston, a database with incentive program, col 12 lines 12-col 41 lines 5-38].

wherein the associating is made explicitly by pointers that are included in terms of the promotions [Eggleston, a pointer, col 34 lines 1-20].

Eggleston also discloses check to access database [Eggleston, col 40 lines 7-24; col 44 lines 5-63]. However Eggleston does not explicitly detail "checking (or searching) a database of promotions for presence of a promotion that includes the qualifying value (or qualifying parameters)";

It was well-known in the database art that a search engine can search by a specified qualifying parameters or keywords as taught by Lakritz [Lakritz, abstract].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the search limited by specified qualifying parameters as taught by Lakritz into the Eggleston's apparatus in order to utilize the database search. Doing so would provide the consumer a simple, fast, easy to use system for generating, identifying and recognizing the interested subjects [Lakritz, col 3 lines 65-col 4 line 3].

4. Claim 2 contains the similar limitations set forth of claim 1. Therefore, claim 2 is rejected for the similar rationale set forth in claim 1.

5. As per claims 3,13 Eggleston-Lakritz disclose the module is associated with the reward value by a pointer of the pointers [Eggleston, a pointer, col 34 lines 1-20].

6. As per claims 4,14 Eggleston-Lakritz disclose the pointer is in the database [Eggleston, a pointer, col 34 lines 1-20].

7. As per claims 6,15 Eggleston-Lakritz disclose the module is associated with the reward value implicitly [Eggleston, associate the award with the incentive program, col 157 lines 8-23].

8. As per claim 7, Eggleston-Lakritz disclose A method for enabling a web server to provide a commercial promotion, comprising the acts of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Lakritz, the search may be limited by specified qualifying parameters, abstract];

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active [Eggleston, current status of the prize in the database, col 21 lines 3-27; current incentive program, col 26 lines 30-61]; and

when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20] and executing a module of

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selectively executable compiled code associated with the reward value [Eggleston, the generated code, col 32 lines 21-52].

9. As per claims 8,18 Eggleston-Lakritz disclose the act of determining whether the promotion that includes the qualifying value is active further includes the act of checking a start date [Eggleston, the beginning date and the ending date of the incentive program, col 33 lines 39-52].

10. As per claims 9,19 Eggleston-Lakritz disclose the act of determining whether the promotion that includes the qualifying value is active further includes the act of checking a stop date [Eggleston, the beginning date and the ending date of the incentive program, col 33 lines 39-52].

11. As per claims 10,16,20 Eggleston-Lakritz disclose the act of advancing a promotion counter in response to executing the module [Eggleston, paid in advance by the sponsoring firm, col 41 lines 5-26].

12. As per claim 11, Eggleston-Lakritz disclose a Programmable media containing programmable software for enabling a web server to provide a commercial promotion, the programmable software comprising the steps of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Lakritz, the search may be limited by specified qualifying parameters, abstract]; and

when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20; the generated code, col 32 lines 21-52].

As per claim 21, Eggleston-Lakritz disclose the programmable software enables one of adding, ending and changing of the promotion by interacting with the database through a database editor [Eggleston, an editor, col 47 lines 18].

13. As per claim 12, Eggleston-Lakritz disclose Programmable media containing programmable software for enabling a web server to provide a commercial promotion, the programmable software comprising the steps of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Lakritz, the search may be limited by specified qualifying parameters, abstract];

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value [Eggleston, current status of the prize in the database, col 21 lines 3-27; current incentive program, col 26 lines 30-61]; and

executing a module of selectively executable compiled code associated with the reward value [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20; the generated code, col 32 lines 21-52].

14. As per claim 17, Eggleston discloses a Programmable media containing programmable software for enabling a web server to provide a commercial promotion, the programmable software comprising the steps of:

detecting a qualifying value of a commercial transaction [Eggleston, prompted to select prizes, col 14 line 66-col 15 line 15; col 19 lines 55-66; col 20 lines 33-67; monitoring behavior, col 39 lines 52-64; filtering, col 41 lines 5-25];

checking a database of promotions for presence of a promotion that includes the qualifying value [Lakritz, the search may be limited by specified qualifying parameters, abstract];

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active

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[Eggleston, current status of the prize in the database, col 21 lines 3-27; current incentive program, col 26 lines 30-61]; and

when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value [Eggleston, determine a win, col 26 lines 30-61; col 31 lines 25-col 32 line 20; the generated code, col 32 lines 21-52.

15. As per claims 22,23 Eggleston-Lakritz disclose creating and defining the promotion by entering the terms of the promotion into the database; and adding, ending or changing of the promotion by interacting with the database through a database editor [Eggleston, database editor, col 49 lines 1-40].

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Thong', with a stylized flourish extending from the end.